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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/600,321 | 06/20/2003 | A.B. Hudson | 34057 | 6166 |

7590 04/26/2005
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EXAMINER

PRATT, HELEN F

ART UNIT PAPER NUMBER

1761

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,321

Applicant(s)

HUDSON, A.B.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 19 recites the broad recitation "at least about 5 weight percent bone meal and at least about 25 weight percent of a palatability enhancer", and the claim also recites a ratio as to the two ingredients, which is the narrower statement of the range/limitation.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 is dependent on cancelled claim 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tayntor (76272) or Heck (3,704,204) or Coyner (2,182,171).

Tayntor discloses a medical compound containing bone dust (bone meal) and a palatability enhancer, which is caraway seed. Heck discloses a composition containing meat (palatability enhancer) and bone meal (col. 3, lines 60-65). Coyner discloses that it is known to feed calves a supplement made of bone meal and calcium (page 1, lines 40-50). Claims 1-3 differ from the reference in the particular amounts of ingredients. However, it is seen that it would have been within the skill of the ordinary worker to use particular amounts of ingredients in the composition. Therefore, it would have been obvious to use known ingredients as shown by the above ingredients to make the claimed compound.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claims 1-3 above, and further in view of Saebo (US 2004/0157932 A1).

Claim 4 further requires that the composition have an ingestible shell and claim 5 that it is biodegradable material and claim 6 that it is a gelatin material. Saebo

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discloses that it is known to use gel caps made from gelatin in animal nutrition (abstract and page 1, para.0007). A hard gelatin capsule is disclosed in para. 0040. The capsule is seen to have been biodegradable as no nutrients could have been used by the animal, if it were not. Therefore, it would have been obvious to make a shell of gelatin as disclosed by Saebo to encapsulate the composition of the above references as Saebo discloses that a gelatin material as an encapsulant for animal supplements.

Claims 7-23, 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tayntor (76272) or Heck (3,704,204) or Coyner (2,182,171) as applied to claims 1-3 above, and further in view of Miller et al. (3,908,025) and Lasater et al. (5,200,218) and Nadeau (6,280,779) and further in view of Payne (3,968,269).

Claim 7 further requires particular amounts of ingredients. Miller et al. disclose a composition containing bone meal and meat meal (col. 2, lines 66-70 and col. 3, lines 30-45). The meat (palatability enhancer) is used in amounts of 19-25T and meat by-products are used in amounts of 0-15%. Lasater et al. disclose bone meal used in various amounts (col. 4, lines 30-65). Nadeau et al. disclose protein (meat) in amounts of 42% and ash (bone meal) in the amounts of 7.82. The protein is 50% of the product and the ash is about 8 %. In diet B, the ash is 10%. The reference discloses the use of steamed bone meal, which is assumed to give the ash content (col. 5, lines 1-70 and col. 6, lines 1-15). Payne discloses that it is known to use meat and bone meal in an animal food. The reference discloses that the ash content was primarily dependent on the bone meal content (col. 4, lines 1-10). Therefore, it would have been obvious to

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use known ingredients, which are known to be palatable to animals such as meat as a palatability enhancer in the claimed amounts as shown by Nadeau. The other references disclose that it is known to use meat and bone in animal foods.

Claims 8-12 further require various ratios of bone meal to palatability enhancer. However, as the reference to Nadeau et al. disclose the claimed amounts, it would have been obvious to vary the amounts for their known function of adding nutrition and flavor to a product.

The limitations of claims 13-18 have been disclosed above and are obvious for those reasons. Claim 13 further requires that the supplement is palatable to dogs and cats. However, the composition has been shown above, and dogs and cats are known to love meat. Therefore, it would have been obvious to make a supplement as claimed.

Claims 19-28 are to a method of giving an animal the claimed supplement. Nadeau et al. disclose a pet food, which contains protein (palatability enhancer) and ash (bone meal) in the claimed amounts. Diet C discloses steamed bone meal, which is assumed to be the source of ash (columns 5 and 6, diets B, C and D). The further limitations as to amounts have been disclosed above and are obvious for those reasons.

ARGUMENTS

Applicant's arguments filed 3-8-05 have been fully considered but they are not persuasive. Applicants argue that the references to Tayntor, Heck and Coyner do not disclose the claimed composition using the claimed ratios of ingredients. However, Applicants are claiming any and all palatability enhancers and nothing is seen that

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caraway seed (Tayntor) would not have been tasty. As to Heck, applicants are claiming a composition, which has been shown by Heck. It is not seen that Heck is only to a medium containing meat and bone meal used to test for salmonellae. Heck discloses that ground meat and bone meal were tested for salmonella (col. 4, lines 25-40). This reference specifically discloses how common the composition of ground meat and bone meal is if it is known to test such for bacteria. Certainly, whether an enhancer is palatable depends on the animal.

As to the amounts of ingredients, it would have been within the skill of the ordinary worker to determine the particular amounts. This is not seen as being "common knowledge". The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In a food supplement, properties such as palatability and nutrition are important. It appears that the precise ingredients as well as their proportions affect the preservation and shelf life of the product, and thus are result effective variables which one of ordinary skill in the art would routinely optimize.

The references to Tayntor, Heck and Coyner are used separately and not in combination.

Applicants argue that the references to Miller, Lasater and Nadeau do not add anything since they do not disclose the claimed ratios.

However, Payne et al. disclose that bone meal is related to ash content and Nadeau et al. does disclose steamed bone meal with meat as the second ingredient and protein in amounts of 54.41%. Bone meal is the only ingredient, which would have

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contributed any appreciable amount of ash (Table VII, col. 5 and 6). Therefore, it is seen that Nadeau et al. does show bone and meat ingredients at within the claimed ratios.

Applicants argue as to Exhibit A that bone meal is not the same as ash and that some of the examples have a lot of ash, and no bone meal. However, bone could have been included in the "meat by-products", and with any of the meats as these ingredients are not necessarily just meat especially for pet foods. At any rate, it is not seen how the other ingredients such as meat, rice, corn starch as in diet C, Table VI, col. 5, would contain any appreciable amounts of calcium, phosphorus, magnesium or other minerals. It is well known that bone contains high amounts of phosphorus and calcium.

Applicants argue that claim 13 contains the limiting language 'consisting essentially of' which excludes the various references. However, nothing has been shown that ingredients such as starch, salt, dextrose and gums Table VI would "materially affect the composition".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

HP 4-21-05


HELEN PRATT
PRIMARY EXAMINER